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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/776,387

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Scott V. Taylor

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APPLIED MEDICAL RESOURCES CORPORATION

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EXAMINER

NGUYEN, TUAN VAN

ART UNIT

PAPER NUMBER

3731

MAIL DATE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/776,387	Applicant(s) TAYLOR ET AL.	
	Examiner TUAN V. NGUYEN	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-63 and 67 is/are pending in the application.
- 4a) Of the above claim(s) 6, 10, 11, 13, 14, 26-30, 32-46, 49-53, 55-63 and 67 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-9, 12, 15-25, 31, 47, 48, 54 and 64-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. In previous Office action, claims 1-5, 7-9, 12, 15-25, 31, 47, 48, 54 and 64-66 were examined and rejected and claims 6, 10, 11, 13, 14, 26-30, 32-42, 43-46, 49-53, and 55-63 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions.

Response to Amendment

2. Applicant's arguments filed on April 15, 2008 with respect to the rejection of claims 1-5, 7-9, 12, 15-25, 31, 47-48 and 54 under 35 USC § 112 have been fully considered and persuasive therefore the previous rejection is hereby withdrawn.
3. Applicant's arguments filed on April 15, 2008 with respect to the rejection of claims under 35 USC § 102 and 103 have been fully considered but they are not persuasive.
 - a. Applicant argues that the pinching member of Gravener does not provide an instrument seal in the embodiment depicted in Figs. 22 and 23 because the middle portion 28 of valve assembly 10 provides sealing to the instrument by longitudinal and radial pressure is incorrect. Gravener clearly discloses, column 8, lines 35-40, "Middle portion 28 of valve assembly 10 provides longitudinal and radial pressure in conjunction with members 96 to the instrument, thus providing and maintaining a substantial gas tight seal". Noting that the pressure of the pinching

members 96 applied on the outer surface of middle portion 28 will enhance the sealing of the valve assembly. Noting that the roller or rollers of the instant application is configured to provide gas tight seal in the absence and the present of the instrument and the roller or rollers are in directed contact with the instrument.

- b. As to claim 3, Applicant argues that there is no item 88 in Fig. 22.

Examiner acknowledges that item 88 depicted in Fig. 21 of Gravener's drawings, thus, line 3, paragraph 15 of the previous Office action should indicated "Fig. 21". Noting that only Fig. 21 of Gravener's drawings that has item 88.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 2, 4, 5, 7, 8, 9, 12, 15, 17, 18, 21, 22, and 47-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Gravener et al (U.S. 5,360,417).**
6. Referring to claims **1, 2, 4, 5, 7, 8, 12, 15, 17, 18, 21, 22, and 47-48**, Gravener discloses (see Figs. 22 and 23) a trocar adapted to provide access for a surgical instrument through a body wall and into a body cavity (see Summary of The Invention), comprising: a cannula 64 having a proximal end and a distal end; a

seal housing, which contains valve 10 assembly, communicating with the cannula to define a working channel; a seal assembly includes valve 10 and rollers 96 disposed within the seal housing; two pinching members or rollers 96, wherein each having an axle supported by the seal housing; and the rollers and middle portion 28 having properties for forming a gas tight seal or fluid tight seal with or without the presence of an instrument (see col. 8, lines 10-40).

7. Referring to **claim 9**, Gravener discloses the valve assembly 10 is designed to accommodate and provide a seal about instrument of varying diameters e.g., diameters of from 3mm to 15 mm (see col. 5, lines 10-16).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
10. **Claims 3 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gravener et al (U.S. 5,360,417).**
11. Referring to claim **3**, Gravener discloses the invention substantially as claimed except for the axle has a fixed relationship with the seal housing and the roller has a pivotal relationship with the axle. However, Figure 21 of Gravener's drawings discloses such a mechanism. Figure 21 discloses the pinching member has a pivotal relationship with the axle 88, wherein axle 88 is fixed with respect to the housing (col. 7, lines 35-41). Therefore, it would have been obvious to one of ordinary skill in the art to perform a simple substitution of one known element for another to obtain predictable results.
12. Referring to claim **23**, Gravener discloses the invention substantially as claimed except for the housing and the roller are formed of translucent material. However, it is old and well known in the art that trocar housing and cannula are formed of translucent or transparent material is for the purpose of providing the surgeons the ability to observe the tissue and the location of the distal tip of the instrument being inserted into the cavity. Extrinsic evidence, Frederick et al (US 6,017,356) discloses the trocar 40 is made from transparent material for the purpose of providing the surgeons the ability to observe the tissue (see Example 2).

13. **Claims 16, 19, 20, 24, 25, 31, and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gravener et al (U.S. 5,360,417) in view of De la Torre et al (US . 6,238,373).**
14. Gravener discloses the invention substantially as claimed except for the roller includes a gel material. However, De la Torre discloses such a material for his device (see col. 10, line 52 to col. 11, line 15 and Fig. 16-16a). Apparently the gel material provides a better compliant between the valve and the outer surface of the instrument thereby providing a better seal between the valve and the instrument. Therefore, it would have been obvious to one of ordinary skill in the art to include the gel material around the rollers 96 so that it too would have the same advantage.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN V. NGUYEN whose telephone number is (571)272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/T. V. N./
Examiner, Art Unit 3731

/Todd E Manahan/
Supervisory Patent Examiner, Art Unit 3731